

Doc Code: AP.PRE.REQ

PTO/SB/33 (06-09)

Approved for use through 07/31/2009. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 2003-0372 / 24061.93	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>July 14, 2009</u></p> <p>Signature <u>Bonnie Boyle</u></p> <p>Typed or printed name <u>Bonnie Boyle</u></p>		Application Number 10/821,016	Filed April 8, 2004
		First Named Inventor Hsiao-Wen Wan, et al.	
		Art Unit 2444	Examiner Peling A. Shaw
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,713</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p><u>Brandi W. Sarfatis</u> Signature Brandi W. Sarfatis Typed or printed name</p> <p><u>214-651-5896</u> Telephone number 7/14/09 Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Hsiao-Wen Wan, et al.	§	Docket No.:	24061.93 / 2003-0372
		§		
Serial No.:	10/821,016	§	Examiner:	Peling A. Shaw
		§		
Filed:	April 8, 2004	§	Art Unit:	2444
		§		
For:	Method for Circulating a Report in a Semiconductor Manufacturing Environment	§	Conf. No.:	9310

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. INTRODUCTION

The present paper is being filed under the Official Gazette Notice of July 12, 2005, and in response to the final Office action mailed April 15, 2009, and the Advisory Action mailed June 29, 2009, in connection with the above-noted application. A Notice of Appeal with the proper fee is being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for any extensions of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

II. REASONS

In the final Office action mailed April 15, 2009, claims 1-5, 7, 10-14, 16 and 19-23 were rejected under 35 U.S.C. 102(b) as being anticipated by Lu et al., "B2B in TSMC Turnkey Services" (hereinafter "Lu") and claims 6, 8-9, 15, 17-18, and 24-26 were rejected under 35 U.S.C. §103 as being unpatentable over Lu in view of U.S. Patent No. 6,363,414 to Nicholls et al. (hereinafter "Nicholls"). Applicants submit that the Examiner has made clear errors in rejecting the claims.

A. Rejections Under 35 U.S.C. § 102

Independent claim 1, as amended, requires *inter alia*:

selecting at least one of a plurality of input files;

selecting an output file format from a plurality of output file formats;

selecting a mode for circulation from a plurality of modes for circulation; . . . and

circulating the output file to at least one recipient entity using the selected mode for circulation.

1. selecting at least one of a plurality of input files

In the final Office action, the Examiner cited the third paragraph on the left column of page 41 and the fifth paragraph on the right column of page 41 as disclosing “selecting at least one of a plurality of input files.” Those paragraphs are reproduced below for ease of reference:

At first, the target was providing the integrated WIP, including WIP in FAB, circuit probing (CP), assembly and final test, yield data and ship alerts to customers. In this period, it produced some kinds of data to ask the subcontractors to provide. These data included electronic purchase orders (e-PO), the confirmed shipping dates from subcontractors (SOD), the lots in the subcontractors' factories (WIP), the transaction of entering inventory (named INSLIP), the lots in subcontractors' finished goods (named FG Bank) and the shipping information (named SHIPOUT). . . .

After developing the phase I and phase II, there is now a proper B2B architecture. But there is still something missing before the system becomes a real B2B system. What is the real B2B system? it must integrate the information, material and cash flows. After phase II was released, it didn't integrate the cash flow into the system. It used the work order and the INSLIP data to make payments automatically. And at the same time, it didn't provide proper data for CRM, SCM and ERP. For these 2 reasons, there are 2 modifications to the system design.

Applicants respectfully traverse the Examiner's position in this regard and submit that the paragraphs teach, at best, entry of INSLIP data, which is clearly not equivalent to selecting at least one of a plurality of input files. In particular, no selecting of any sort of file is taught, much less selection of one of a plurality of input files as recited in claim 1. Moreover, the Examiner's statement in section 11.b. of the Advisory Action that the teaching of the above-noted paragraphs “seems to allow selecting from different inputs” (emphasis added) evinces the Examiner's lack of certainty concerning the teachings of Lu in this regard and appears to be based on a general feeling of the Examiner about the teachings of the reference as opposed to what the reference actually teaches.

2. selecting an output file format from a plurality of output file formats

The Examiner cites the final paragraph on page 43 through the first paragraph on page 44 as disclosing “selecting an output file format from a plurality of output file formats.” That paragraph is reproduced below for ease of reference:

Originally, subcontractor will inform TSMC when the lot was finished though e-mail, phone or FAX. After getting the information, TSMC could send a shipping instruction to subcontractors and a shipping alert to customers through FAX. The new system changes the flow of shipment. When subcontractors complete the lot, they will send an INSLIP transaction to TSMC. After receiving the INSLIP transaction, the system will processes some checks to make sure the good is ready for shipping automatically. If the lot is ready, then the system will send a shipping instruction through a XLM format to the subcontractors and a shipping alert to the customer through e-mail. The new flow could

reduce by at least 2 days the time from lot finish to shipment, auto issues shipping instructions instead of FAX and auto issue shipping alerts to Customer instead of FAX.

Again, Applicants respectfully traverse the Examiner's position and submit that the cited text, reproduced above, merely teaches sending data in a single predetermined output file format (i.e., XML format); it clearly fails to teach selection of an output file format from a plurality of available formats. Once again, the Examiner's comments in the section 11.b of the Advisory Action that "Lu seems to have the . . . limitations" (emphasis added) evinces the Examiner's lack of certainty concerning the teachings of Lu in this regard.

3. *selecting a mode for circulation from a plurality of modes for circulation and circulating the output file to at least one recipient entity using the selected mode for circulation*

The final paragraph on page 43 through the first paragraph on page 44 is also cited as teaching "selecting a mode for circulation from a plurality of modes for circulation . . . and circulating the output file . . . using the selected mode for circulation." Yet again, Applicants respectfully traverse the Examiner's position and submit that the cited text teaches only a single mode for circulation (i.e., e-mail); it clearly fails to teach selection of a mode from a plurality of modes and then circulating the output file using the selected mode, as recited in claim 1.

In summary, the system of Lu discloses a system for circulating data in a fixed format via a fixed mode of communication. Clearly, such a system is not anticipatory of the system clearly recited in claim 1. In view of the foregoing, it is apparent that Lu fails to anticipate claim 1 and the subject rejection should therefore be withdrawn. Independent claims 10 and 19 includes limitations similar to those of claim 1 in this regard and is therefore also deemed to be allowable over Lu. Claims 2-5, 7, 11-14, 16, and 20-23 depend from and further limit claims 1, 10, and 19 and are therefore also deemed to be in condition for allowance for at least that reason.

B. Rejections Under 35 U.S.C. § 103

Claims 6, 8-9, 15, 17-18, and 24-26 stand rejected under 35 U.S.C. §103 as being unpatentable over Lu in view of U.S. Patent No. 6,363,414 to Nicholls et al. (hereinafter "Nicholls"). In response, Applicants submit that, in view of the fact that claims 6, 8-9, 15, 17-18, and 24-26 depend from and further limit independent claims 1, 10, and 19, the claims are deemed to be in condition for allowance for at least that reason.

III. CONCLUSION

In view of the fact that there are clear errors in the Examiner's position, as demonstrated above, it is apparent that the rejection of the pending claims under 35 U.S.C. §102 and §103 is not supported by the references and should therefore be withdrawn. Accordingly, all of the pending the claims in the application being in condition for allowance, such action is respectfully requested.

Respectfully submitted,

Brandi W. Sarfatis

Registration No. 37,713

Date:

7/14/09

HAYNES AND BOONE, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219
Telephone: 214/651-5896
Facsimile: 214-200-0853

D-1771158_I.DOC

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically
filed with the U.S. Patent and Trademark Office via EFS-Web
System on July 14, 2009

Bonnie Boyle
Bonnie Boyle